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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/631,204

07/31/2003

James E. Selis

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EXAMINER

TYSON, MELANIE RUANO

ART UNIT

PAPER NUMBER

3773

MAIL DATE

DELIVERY MODE

03/12/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/631,204	<b>Applicant(s)</b> SELIS, JAMES E.	
	<b>Examiner</b> Melanie Tyson	<b>Art Unit</b> 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 81-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 81-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 November 2008 has been entered. Claims 1-80 have been cancelled. New claims 81-96 have been added.

### ***Response to Amendment***

The affidavit under 37 CFR 1.132 filed 17 December 2008 is insufficient to overcome the rejection of claims 61-64, 67-72, and 76-79 based upon Hoyns as set forth in the last Office action because: Hoyns teaches the clip pierces target tissue and anchors itself in tissue, thus does not teach away from the claimed invention. To modify the shape of the clip as claimed is an obvious modification that would not prevent Hoyns clip to be employed as intended. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

### ***Response to Arguments***

Applicant's arguments with respect to the Hoyns reference have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 81, 83-86, 89, 91, 92, and 94-96** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hoyns et al. (U.S. Patent No. 6,766,186 B1) in view of Foerster et al. (U.S. Publication No. 2001/0034528 A1)**. Hoyns discloses a metal clip (see entire document) consisting essentially of a first arc segment (61), a second arc segment (62), and an apex (65) where the arc segments adjoin and converge (for example, see Figure 14), wherein the clip is configured to penetrate tissue (for example, see column 6, lines 48-50), forms generally two back to back C shaped segments (for example, see Figure 14), and is capable of being deployed as claimed. Hoyns further suggests that the largest dimension of the clips when deployed are less than 5 mm (for example, see column 4, lines 51-57 and column 5, lines 51-54; wherein the tubing 45 is about half the length of the entire clip). Hoyns fails to disclose the first ends of the first

and second arc segments project in a direction away from the second ends of the first and second arc segments pre-deployment and post-deployment.

Foerster discloses an arc shaped clip for marking tissue (see entire document; Figure 12 illustrates an arc, or “C” shaped clip). Foerster teaches the first end projects in a direction generally away from the second end so that the ends are able to anchor themselves into the tissue to permanently secure the marker element in the desired location (for example, see paragraph 59). Thus, it would have been recognized by one of ordinary skill in the art that applying the known technique taught by Foerster to the clip of Hoyns (forming the first end such that it projects in a direction generally away from the second end) would have yielded predictable results, namely, a clip that would anchor itself in tissue permanently to further prevent migration from its intended location.

**Claims 82, 87, 88, 90, and 93** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hoyns et al. in view of Foerster et al.** as applied to claim 81 above, and further in view of **Voegelé (U.S. Patent No. 6,425,903 B1)**. Hoyns in view of Foerster discloses the claimed invention except for a coating. Voegelé discloses a clip (see entire document). Voegelé teaches the clip may be coated to lower friction, stop bleeding, or accomplish any other desired effect (for example, see column 8, lines 30-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the clip of Hoyns in view of Foerster with a coating as taught by Voegelé. Doing so would provide the clip with the advantages described above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Friday 7-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./  
Examiner, Art Unit 3773  
March 9, 2009

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773